

REMARKS

Claims 31-51, 53 and 54 have been amended. Claim 52 has been canceled. Thus, claims 30-51, 53 and 54 are now pending in the present application. Support for the amendment to claim 35 may be found, for example, if Fig. 5. Thus, no new matter has been added. Reconsideration and withdrawal of the present rejections in view of the comments presented herein are respectfully requested.

Claim objections

The Examiner noted that the claim numbering was not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout prosecution. The Examiner stated that misnumbered claims 26-50 have been renumbered as claims 30-54. Thus, the claims as presented herein have been renumbered as claims 30-54, and the dependencies corrected accordingly.

Specification

The Examiner objected to the specification as allegedly failing to provide proper antecedent basis for recitation of: 1) "the third and fourth optical fibers" in claim 35, lines 10-11; 2) "the third optical fiber" in claim 42; and 3) "third longitudinal translatory element" in claim 52, lines 1-2. This language has been removed from claims 35 and 42, and claim 52 has been canceled.

Rejections under 35 U.S.C. § 112, first paragraph

Claims 35-38 and 43 were rejected under U.S.C. § 112, first paragraph as allegedly failing to comply with the written description requirement. In particular, the Examiner contends that the "third and fourth optical fibers" in claim 35, lines 10-11, is not adequately supported in the original disclosure. Claim 35 has been amended to recite the arrangements of the fibers without this language, consistent with the embodiment shown in Fig. 5.

The Office Action also notes that the phrase "the third optical fiber second ends" in claim 42, lines 1-2 is not clear, and that there is insufficient antecedent basis for this limitation. Claim 42 as amended no longer recites this term.

In view of the comments presented above, Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. § 112, first paragraph.

Obviousness-type double patenting

Claims 30 and 53 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 28 and 50, respectively, of copending Application No. 10/556,919. Applicants note that Application No. 10/556, 919 is now abandoned in favor of a continuation application (Application No. 12/689,182, filed on January 18, 2010) which contains essentially the same claims as the parent application. Enclosed herewith is a terminal disclaimer over Application No. 12/689,182, thus overcoming this rejection.

Claim 35 was rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 7,037,325 (Svanberg et al.). Present claim 35 recites a longitudinal translatory element that is arranged to be radially outwardly moveable and integrated with the disc which is neither disclosed nor suggested by claim 1 of Svanberg et al. Thus, Applicants respectfully request reconsideration and withdrawal of the obviousness-type double patenting rejection over this reference.

Rejections under 35 U.S.C. § 103(a)

Claims 30-32, 41, 42, 44, 46, 47-51, 53 and 54 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Svanberg (US 2004/02060366) in view of Willett (US 4,669,467).

Claims 33, 34 and 52 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Svanberg (US 2004/02060366) in view of Willett (US 4,669,467), and in further view of Daniel (US 4,496,211).

Claim 45 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Svanberg (US 2004/02060366) in view of Willett (US 4,669,467), and in further view of Seibel (US 2001/0055462).

The Svanberg reference cited by the Examiner qualifies as prior art only under 35 U.S.C. § 102(e). According to 35 U.S.C. § 103(c) (1), “[s]ubject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.” The presently claimed invention and the subject matter of US 2004/02060366 were, at the time the claimed invention was made, subject to an obligation of assignment to SpectraCure AB. Thus, US 2004/02060366 does not qualify as prior art,

and cannot be used as the basis of an obviousness rejection of the present claims. Since all of the obviousness rejections are based on these references, the rejections are therefore moot.

The Examiner may note that the PCT publication corresponding to US 2004/02060366 (WO 03/041575) was published on May 22, 2003, which is prior to the May 14, 2004 PCT filing date of the present application. However, the present application claims priority to two Swedish priority applications (0301406-5 and 0301410-7, both filed on May 14, 2003). Thus, these priority applications were filed prior to the PCT filing date of the cited reference. Enclosed is a copy of Swedish Application No. 0301406-5 (which was filed in English), the disclosure of which fully supports all of currently pending claims. Thus, WO 03/041575 does not qualify as prior art against the present claims.

In view of the comments presented above, Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a).

No Disclaimers or Disavowals

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, Applicant is not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. Applicant reserves the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that Applicant has made any disclaimers or disavowals of any subject matter supported by the present application.

CONCLUSION

Applicants submit that all claims are in condition for allowance. However, if minor matters remain, the Examiner is invited to contact the undersigned at the telephone number provided below. If any additional fees are required, please charge these to Deposit Account No. 11-1410. Should there be any questions concerning this application, the Examiner is respectfully invited to contact the undersigned at the telephone number appearing below.

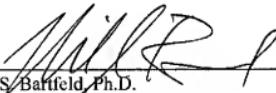
Appl. No.: 10/556,806
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Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 2/5/10

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